

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – Art Unit 09/541,326
Attorney Docket No. 294438007US

REMARKS

In the final Office Action mailed April 7, 2003 (Paper No. 10), the Examiner rejected claims 9-48, 54-80, and 86-93 under 35 U.S.C. § 102(e) over Ockerman, J., Najjar, L., and Thompson, J., "Wearable Computers for Performance Support: Initial Feasibility Study," Digest of Papers, First International Symposium on Wearable Computers, 1997 ("Ockerman"). For the reasons discussed in detail below, applicants submit that the application is in condition for allowance.

The finality of the present Office Action is premature. As noted in MPEP § 706.07(b), "it would not be proper to make final a first Office Action in a continuation-in-part application where any claim includes subject matter not present in the earlier application." Applicants submit that the present application, which is a continuation-in-part of U.S. Patent Application Nos. 09/216,193 and 09/464,559, contains at least one claim including subject matter not present in the claims of either of these parent applications. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the finality of the pending Office Action in accordance with MPEP § 706.07(d).

Rejection of the claims under subsection (e) of 35 U.S.C. § 102 over a non-patent prior art reference is improper. As can be seen from the copy of 35 U.S.C. § 102(e) quoted in the Office Action, subsection (e) applies only where the claimed invention is described in a U.S. Patent. As Ockerman is not a U.S. Patent, it cannot provide a basis for a proper rejection under 35 U.S.C. § 102(e). Accordingly, applicants hereafter treat the rejection under 35 U.S.C. § 102(e) as having been made under 35 U.S.C. § 102(b), which applies to all types of printed publications.

The claims are also not properly rejected over Ockerman under 35 U.S.C. § 102(b). To establish a prima facie case of anticipation under 35 U.S.C. § 102(b), the Examiner must identify where "each and every facet of the claimed

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – Art Unit 09/541,326
Attorney Docket No. 294438007US

invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990). Indeed, the failure to mention "a claimed element (in) a prior art reference is enough to negate anticipation by that reference." *Atlas Powder Co. v. E.I. duPont De Nemours*, 750 F.2d 1569, 1574 (Fed. Cir. 1984). Moreover, anticipation requires that each claim element must be identical to a corresponding element in the applied reference. *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). These requirements have not been fully satisfied for any of the pending claims.

Claim 9 recites three steps. In the rejection of claim 9, the Examiner has identified portions of Ockerman asserted to disclose each of these steps. Applicants not only disagree that the identified portions of Ockerman fail to identically disclose the recited steps for which they are identified, but also fail to find any correspondence whatsoever between the steps and the portions identified for them. For the step of "displaying a list of context attributes available in the computing device," the Examiner identifies the following sentence of Ockerman: "For example, the display allows the user to work while looking at text, drawings, and video." Applicants fail to appreciate how the latter could be said to identically disclose the former. Applicants submit that allowing a user to look at text, drawings, and video in no way constitutes displaying a list of context attributes available in the computing device as recited.

For the step of "receiving user input identifying a subset of the displayed available context attributes for logging," the Examiner identifies the following sentence of Ockerman: "The earphone allows the user to hear explanatory audio narration while looking at information on the display or at the task environment." Applicants fail to appreciate how the latter can be said to identically disclose the former, and submit that allowing a user to hear explanatory auditory narration while looking at something in no

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – Art Unit 09/541,326
Attorney Docket No. 294438007US

way constitutes receiving user input identifying displayed available context attributes for logging as recited.

For the step of "selecting the identified context attributes for logging," the Examiner identifies the following sentence of Ockerman: "The microphone, voice recognition software, and our applications allow the user to control the computer via voice so the user's hands are free for other tasks." Applicants fail to appreciate how the latter could be said to identically disclose the former, and submit that allowing a user to control a computer via voice to free the user's hands for other tasks in no way constitutes selecting identified context attributes for logging as recited.

For claims 10-12, the rejection similarly identifies portions of Ockerman that appear to bear no relationship whatsoever to the additional features recited by these claims, let alone identically disclose these recited features. Because the portions of Ockerman identified by the Examiner as corresponding to the features recited by claims 9-12 fail in each case to identically disclose the features recited by these claims, applicants submit that the rejection of these claims is improper and should be withdrawn.

For claims 13-48, 54-80, and 86-93, the Examiner has failed to satisfy the requirement of identifying where each claim element is disclosed in Ockerman. Despite a statement by the Examiner to the contrary, each of these claims contains one or more elements not contained in the claims specifically addressed by the Examiner. Because the rejection fails to identify portions of Ockerman identically disclosing the features recited by these claims, applicants submit that the rejection of these claims is improper and should be withdrawn.

In view of the foregoing, each claim pending in the application is in condition for allowance. A prompt notice of allowance is therefore respectfully requested. In the

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – Art Unit 09/541,326
Attorney Docket No. 294438007US

event that the Examiner fails to issue a notice of allowance, as noted above, applicants respectfully request that the Examiner withdraw the finality of the present Office Action.

Respectfully submitted,

Perkins Coie LLP

Steven D. Lawrenz
Registration No. 37,376

Date: June 17, 2003

Correspondence Address:

Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 583-8888